

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 21 and 22 are rejected under 35 U.S.C. 103(a) over the U.S. patent to Tsoi in view of the U.S. patent to Baals.

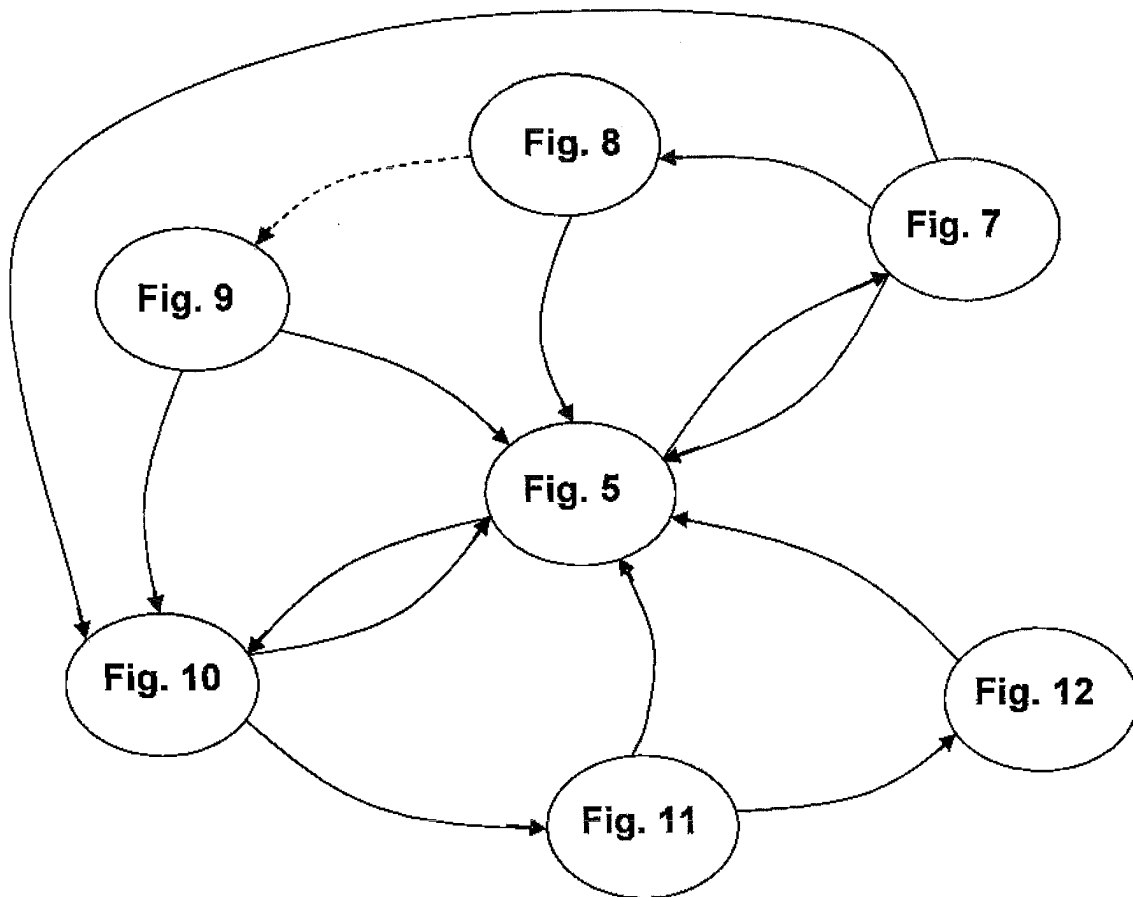
After carefully considering the Examiner's grounds for the rejection of the claims over the art, applicant canceled claim 21, and submitted a new claim 23, the broadest claim on file.

Dependent claim 22 has been amended to depend on claim 23.

It is respectfully submitted that the new features of the present invention which are now defined in claim 23 clearly and patentably distinguish the present invention from the references.

In Tsoi, either all or certain ones of the soft keys are associated with a control function displayed on the auxiliary display. When the soft keys have no associated function, the auxiliary display is blank in the region adjacent the soft key.

While the transitions between states are not clearly described in Tsoi, it would appear that the following transitions are possible through the pressing of the indicated soft keys:



As can be seen, only two of the transitions are "reversible", those between the states of Fig. 5 and Fig. 7 and the states of Fig. 5 and Fig. 10.

In each of the states shown in Figs. 5, 7 and 10, in the screen associated with the soft keys, when a key has no associated function, the display immediately adjacent the key is blank.

Baals, on the other hand has a single display which has a top section in which general information is displayed and a bottom section in which information relating to soft keys is displayed. As with Tsoi, when there are soft keys with no associated function, as in Fig. 2 or Fig. 4, the lower part of the display immediately adjacent these non-operative soft keys is blank. In Fig. 6, none of the soft keys are operative and both the top and bottom parts of the display are used to display the message "ENTRY Klein HAS BEEN ADDED TO YOUR DIRECTORY". It is to be noted that there is a difference in case in the lower part between when the text is associated with a soft key and when general information is displayed. Also, when general information is displayed, none of the soft keys are active. The message shown in Fig. 6 is one which concludes the process of storing an entry in the phone book and is essentially a confirmation message, with no return to an earlier state.

In the radio apparatus defined in claim 21, two control elements are recited which are usable to toggle between first and second operating states. In the first state, the second control element activates the second state and in the second state, the first control element activates the first state. In the first state, information about the first state is associated with the first control element and in the second state, information about the second state is associated with the second control element.

Considering Fig. 5 of Tsoi to correspond to the first operating state, button 82 activates the second state shown in Fig. 7. In Fig. 7, however, button 82 is used to select the call state, i.e. a transition to the state shown in Fig. 8. Similarly, in the state of Fig. 5, button 84 activates the state shown in Fig. 10, in which button 84 controls the transition to the state of Fig. 11. Accordingly, there is no teaching of an arrangement in which pressing a button causes a transition to a different operating state in which that button has no function - in each case the button is associated with a function for transitioning to a further operating state.

The Examiner's statement that "Tsoi does not specifically disclose wherein said first or second control element having no function and merely the information about said first or second operating state are assigned", is therefore misleading because this document specifically teaches that the first or second control element does have a function, that of transitioning to a third operating state.

The use of the areas of the display to display additional information would not lead to the claimed subject matter which recites a particular relation between the properties of the control elements for transitioning to particular states in combination with the display of information

with no function associated with those particular control elements. The examiner's comments appear to be directed to displaying information in areas associated with control elements which are not used for transitioning between the first and second states.

Further, the teaching of Baals is to display information about a state in the areas associated with the control elements only when none of the available control elements has an associated function. When a function is associated with one or more control elements, only information relating to that function is displayed, otherwise, the screen area is left blank.

The original claims were rejected over these references in their combination as being obvious. As explained herein above, the references did not disclose the new features of the present invention as now defined in claim 23, and the references did not have any hint or suggestion for such features. Therefore, any combination of the references would not lead to the present invention as defined claim 23. In order to arrive at the present invention from a combination of the references, the references have to be fundamentally modified by including into them the above-specified new features of the present invention which were first proposed by the applicant.

However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification. This principle also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

It is therefore believed to be clear that claim 23 should be considered as patentably distinguishing the present invention from the prior art and should be allowed, together with claim 22.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



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